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**OFFICE OF PETITIONS**

In re Application of  
Nelms, et al.  
Application No. 10/085,454  
Filed: February 27, 2002  
Attorney Docket No. DSC-7A  
For: NON-RECTANGULAR SHAPED CREDIT  
CARD WITH CASE

: DECISION ON PETITION  
: UNDER 37 CFR §1.78(a)(3)

This is a decision on the reconsideration petition under 37 CFR §1.78(a)(3), filed March 21, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §1.78(a)(2)(ii). In addition, the petition under 37 CFR §1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 CFR §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in §1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1)

37 CFR §1.78(a)(2)(i) requires that any a nonprovisional application claiming the benefit of a prior-filed copending nonprovisional application be amended to contain a reference to the prior-

filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship between the applications.

The substitute amendment filed with this petition complies with 37 CFR §1.78(a)(2)(i) with respect to the relationship of the instant application to application no. 29/133,861.

However, it is noted that petitioners have altered the original 35 U.S.C. §119(e) benefit claim to provisional application no. 60/306,743. Petitioners now are requesting a 35 U.S.C. §120 benefit of provisional application no. 60/306,743 by including a relationship between application no. 10/085,454 and application no. 60/306,743. Such a claim may have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. §154(a)(2).

Accordingly, before the petition under 37 CFR §1.78(a)(3) can be granted, a renewed petition under 37 CFR § 1.78(a)(3) and, if appropriate, a substitute amendment (complying with 37 CFR §1.121) setting forth the entire replacement paragraph and clarifying whether petitioners desire a 35 U.S.C. § 119(e) benefit of provisional application no. 60/306,743 or a 35 U.S.C. § 120 benefit of provisional application no. 60/306,743 is required.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230.



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